

III. REMARKS

1. Claims 1-2, 5, 8, 11, 19-20 and 22-26 are not anticipated by Tait et al. (US 5,550,358) ("Tait") under 35 U.S.C. §102(b).

Claim 1 recites setting up a secure wireless data transmission link between the auxiliary device and another electronic device using the "selected key code". This is not disclosed or suggested by Tait. Rather, Tait discloses (see column 3 lines 18-22) that the data stored in the non-contacting transaction system is transmitted only if the correct PIN number is keyed in using the keypad of the transmitter in the non-contacting transaction system. Tait does not disclose or suggest that the correct PIN number is transmitted or that it is actively used for the encryption of the data. In Applicant's invention, the selected key code is used to set up the secure wireless data transmission link. Contrastingly, in Tait, encryption is not used for transmitting data and therefore a "secure wireless data transmission link", such as that claimed by Applicant, cannot be established.

Tait discloses, in column 6, lines 57 - 66, that encryption may be used to encrypt and transmit the stored data. However, Tait does not disclose or suggest that the encryption should involve the use of the PIN number that is stored in the chip, separate from the chip containing the encryption algorithm.

Thus, each feature of claim 1 is not disclosed or suggested by Tait, and claim 1 is not anticipated. Claims 11 and 19 are similarly not disclosed or suggested and should also be allowable. Accordingly, the dependent claims should at least be allowable in view of their respective dependencies.

Regarding claims 8 and 20, Tait does not disclose or suggest a "wireless portable hands-free set" as is claimed by Applicant, e.g. used as an auxiliary device of an electronic device. Typically, wireless portable hands-free sets comprise an earpiece or an earphone provided with a microphone. Tait discloses a hand-held transmitter (Part 10, Fig. 1), which is not the same as a "wireless portable hands-free set". Thus, claims 8 and 20 are not disclosed or suggested and should be allowable.

Regarding claims 22 and 25, Tait does not disclose a wireless smart card reader. Tait only discloses a hand-held transmitter (Part 10 Fig. 1). The transmitter may contain information related to several credit cards so that the transmitter 10a can be used with more than one credit card. (Col. 5, lines 53-67). However, this hand-held transmitter 10a shown in FIGS. 2, 4 and 7 of Tait is not a device for reading "smart" cards. All that is shown in Tait is a receiver 12 coupled to a "conventional card swipe machine 30" by a "**cable and connector 32, 34**" (Col. 5, lines 11-12). This is not the same as the "wireless smart card reader" as is described and claimed by Applicant. Thus, the features of claims 22 and 25 are not disclosed or suggested by Tait and the claims should be allowable.

Regarding claims 23, 24 and 26, Tait does not disclose the other device being a mobile phone. Tait merely states that RF circuits could be added to the transmitter and receiver so that the user is able to complete transactions remotely. This is not a mobile phone as claimed by Applicant. Tait relates to a conventional card swipe machine (Part 30, Fig. 1) comprising a receiver (Part 12, Fig. 1). Thus, each feature of claims 23, 24 and 26 are not disclosed or suggested and the claims should be allowable.

2. Claims 3, 9, 12-14, 15-17 and 27 are not unpatentable over Tait in view of Nishiyama (US 5,436,954) under 35 U.S.C. §103(a). Claims 3,9, 12-14 and 15-17 should be allowable at least in view of their respective dependencies.

Regarding claim 27, the hand-held transmitter of Tait does not disclose a display device fixed to it as noted by the Examiner. The portable radio telephone set disclosed in Nishiyama uses a rotary selector by means of which the menu displayed on the display section of the portable radio telephone set is controlled. The rotary selector of Nishiyama cannot be used without the display section to control the position of a cursor or to select letters or symbols (column 8 lines 33 - 43). As mentioned in claim 27, the device according to the invention is provided without display and keypad. Therefore, a person of ordinary skill in the art would not be motivated to combine the teachings of Tait and Nishiyama because the hand-held transmitter of Tait is not a radio telephone set, does not comprise a similar display section, and does not include a rotary selector switch, and Nishiyama is not directed to a transaction system as is Tait.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142). As noted above, Tait in view of Nishiyama does not disclose or suggest each feature of Applicants' invention as claimed.

Furthermore, neither reference provides the requisite suggestion or motivation to modify the references as proposed by the Examiner. The Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not supported by the factual contents of Tait in view of Nishiyama. Tait is directed to a remote wireless transaction system that has a hand held transmitter. (Abstract). A receiver is coupled to a conventional card swipe machine. (Col. 5, lines 11-12). "Communication between the transmitter and the receiver is exclusively one-way." (Abstract, lines 12-13). There is nothing in Tait regarding the use of a radio telephone in this transaction system. Nishiyama is directed to a foldable radio telephone set with a rotary selector to select various functions. There is nothing in Nishiyama that would relate to use of this foldable radio telephone set for the transactions described in Tait. Thus, the references themselves and/or the knowledge generally available to one of skill in the art does not provide the requisite motivation or suggestion to modify the references as proposed for purposes of 35 U.S.C. §103(a). When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation to combine the radio telephone of Nishiyama with the transaction system of Tait appears in the references. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Tait in view of Nishiyama under 35 U.S.C. §103(a) is not established.

Additionally, it is respectfully noted that Tait and Nishiyama have been combined improperly. References may be combined under 35 U.S.C. §103(a) only if the references are analogous art. In

this case Tait and Nishiyama are not analogous art. A reference is analogous art if:

- 1) The reference is in the same field of endeavor as the applicant's, or
- 2) The reference is reasonably pertinent to the particular problem with which the applicant was concerned.

Neither Tait nor Nishiyama are in the same field as the Applicants' invention. Tait is directed to a non-contacting transaction system that relies on a hand-held transmitter and a conventional card swipe machine 30. On the other hand, Applicants' invention is directed to a providing an electronic device, and in particular a wireless communication device, into which a key code can be entered and a secure wireless data transmission link can be set up between the electronic device (auxiliary device) and another electronic device. Tait makes absolutely no disclosure or suggestion related to establishing a secure wireless data transmission link. In fact, the only communication between the transmitter and receiver is "exclusively one-way". (Abstract).

Similarly, Nishiyama is not reasonably pertinent to the particular problem with which the Applicants were concerned. The Applicants are concerned with establishing a secure wireless transmission link as recited in the claims. Nishiyama is not reasonably pertinent to that problem. Nishiyama is a foldable radio telephone set with a rotary selector to select various functions. Nothing in Nishiyama relates to using a key code to establish a secure wireless data transmission link between an auxiliary device and another electronic device as is claimed by Applicant.

Thus, Tait and Nishiyama do not address the problems addressed by Applicants' invention. Since Tait and Nishiyama are not in the same field of endeavour as the Applicants' endeavour and are not reasonably pertinent to the particular problem with which the Applicants were concerned, Tait and Nishiyama are not analogous art. Therefore, Tait may not properly be combined with Nishiyama for purposes of 35 U.S.C. §103(a).

Thus, claim 27 should thus be allowable.

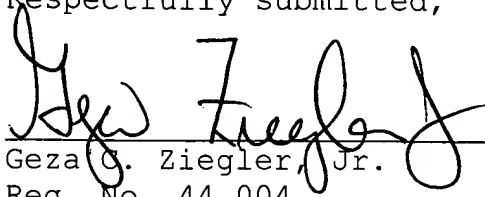
3. Claims 4, 6-7, 18 and 21 are not unpatentable over Tait in view of Rahman et al. (5,627,355) ("Rahman") under 35 U.S.C. §103(a). These claims should be allowable at least by reason of their respective dependencies.

4. Claim 10 is not unpatentable over Tait and Rahman and further in view of Fraccaroli under 35 U.S.C. §103(a), because Fraccaroli, US 6,549,768, is not prior art against Applicant's invention. Nokia Corp., the assignee of the instant application, commonly owns Fraccaroli. Thus, pursuant to 35 U.S.C. §103(c), since both Fraccaroli and Applicant's invention, were, at the time of Applicant's invention, commonly owned, Fraccaroli is not prior art for purposes of 35 U.S.C. §103(a). Therefore, claim 10 is allowable.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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